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STORAGE TECHNOLOGY CORPORATION  
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**AUG 11 2005**

**OFFICE OF PETITIONS**

In re Application of  
Milligan, et al.  
Application No.: 10/791,205  
Filed: March 2, 2004  
Attorney Docket No.: 2003-023-DSK  
For: CANISTER-BASED STORAGE SYSTEM

**DECISION REFUSING STATUS  
UNDER 37 CFR 1.47(a)**

This is a decision on the petition under 37 CFR 1.47(a), filed June 30, 2004 (certificate of mailing date June 28, 2004).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on March 2, 2004 without an executed oath or declaration. Accordingly, on May 24, 2004, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring, an executed oath or declaration, a surcharge for its late filing, and replacement drawings within an extendable two month period from the mail date of the notice.

In response, on June 30, 2004 (certificate of mailing date June 28, 2004), the surcharge, a declaration executed by ten of eleven joint inventors, authorization to charge the petition fee, and the instant petition were filed.<sup>1</sup> Attorney Timothy R. Schulte argues that non-signing joint inventor Jacques Debiez has constructively refused to join in the filing of the above-identified application.

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<sup>1</sup>Regarding finances, deposit account no. 19-4545 will be charged the required \$130.00 Rule 47 petition fee, which is the fee that was due on June 30, 2004, when the Rule 47 petition was filed. In addition, the same deposit account will be charged a two month extension of time fee of \$420.00. This is the fee that was due on September 17, 2004, when applicants submitted replacement drawings in response to the May 24, 2004 Notice.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130.00
- (4) the last known address of the omitted inventor(s).

This petition lacks item (1) above.

As to item (1), Applicants have failed to establish that the inventor has refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. **The Office requires that the non-signing inventor be provided with a complete copy of the application as filed.** This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d).

In the June 11, 2004 e-mail from Inventor Debiez to Ms. Stephanie Klepp, Inventor Debiez alleges "misappropriation made visible" and states that he and his attorney will carefully check any further applications that his former employer, StorageTek, files on topics he worked on and will notify authorized agencies with any discrepancies. He states that there will be lawsuit consequences for StorageTek about any submission related to the canister concept or anything he was involved in as a principal inventor. He states it would have been easier to keep him updated and to find an agreement.

The fact that Inventor Debiez threatens lawsuits does not absolve StorageTek of providing him with a copy of the application as filed and a declaration for patent application. As a named inventor, he will be entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make his position of record in the application.

Inventor Debiez must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. When petitioners can show that Inventor Debiez was mailed or recieved the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration, petitioners will have satisfied this requirement.

In addition, the undersigned would like a copy of the letter (translated if necessary) referenced in the May 22, 2003 e-mail from Florence Melou to Dale L. Boland, written by Inventor Debiez and addressed to STK HQ legal department, that states Inventor Debiez will take them to court if he receives a patent correspondence at his private address.

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**By hand:** U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Petition  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

**By FAX:** (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

A handwritten signature in cursive script, appearing to read "E. Shirene Willis".

E. Shirene Willis  
Senior Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy